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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 06/627,270 | 04/04/96 | TOJO | H SKU-104-A-1 |

QM11/0607

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EXAMINER

GORSKI, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3726 | 17 |

DATE MAILED: 06/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | | | |
|-----------------|--------|----------------|-------------|
| Application No. | 627270 | Applicant(s) | TOJO et al. |
| Examiner | GORSKI | Group Art Unit | 3726 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 4/19/99.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 14-16, 19, 20, 26, 27 and 30-37 is/are pending in the application.

Of the above claim(s) 14-16, 19 and 34-36 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 20, 26, 27, 30-33 and 37 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) 14-16, 19 and 34-36 are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - All
 - Some*
 - None of the CERTIFIED copies of the priority documents have been
 - received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit: 3726

Prosecution on the merits is hereby regretfully reopened. However, based upon the comments contained in the reply brief, the following rejection is now deemed appropriate.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swidler '436.

Swidler '436 discloses a method, comprising the steps of:

painting an automobile so that it is paint-finished; and then

coating strippable paint onto a painted surface of the paint-finished automobile.

Swidler '436 fails to disclose the step of "assembling the paint-finished automobile by mounting an engine and functional parts thereto," after the strippable paint has been applied thereto.

Art Unit: 3726

However, Swidler applies the strippable paint to form a protective film on the automobile, and Swidler recognizes that protection of the automobile is required during the assembly process (see column 1, lines 11-12). Accordingly, one having ordinary skill in the art would have found it obvious to apply the strippable paint of Swidler prior to and leave it on while performing the assembling process, in order to protect the automobile from injury during the assembly process.

The inspection step of claim 26 would have been obvious, since such is conventional in the manufacture of automobiles.

Claims 27, 30-33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler '436.

The subject matter of these claims are properly held to be matters of engineering design choice for the reasons as expressed in the Examiner Answer.

The rejections contained in the Examiner's Answer are hereby repeated and maintained.

The questions posed by the examiner on pages 6-7 of the Examiner's Answer must be addressed in response to this office action. The following question must also be addressed:

Was it known in the art, prior to Applicant's invention, to apply a strippable paint onto small parts?

What does Applicant wish to convey by stating at page 2, lines 7-8 of the specification, "With respect to small parts, a strippable paint has been sprayed on them to form a protective film"?

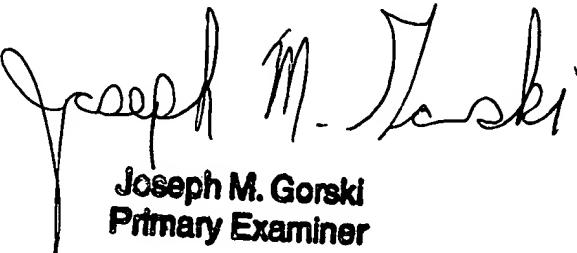
Art Unit: 3726

The following comments are in response to certain issues raised in the Reply Brief:

- 1) It is not the examiner's position that no nexus is shown because the claims are broader in scope than the specifically disclosed embodiments of the invention. Rather, the claims fail to recite the "essential" features of the invention, which results in the lack of a nexus.
- 2) Applicant is requested to state exactly what Applicant intends by claim 27.
- 3) The main purpose of the claims is to accurately and fairly represent the invention, such that one skilled in the art would understand from the claims that to which Applicant seeks protection. To be considered in drafting the claims is ensuring that the claims distinguish the invention over the prior art.
- 4) The authority/propriety for the questions raised by the examiner is to ensure that the examiner has considered all relevant information in performing a complete and thorough examination of the application.
- 5) Does Applicant intend for the claims to require that the "assembling" step is performed while the strippable paint remains on the automobile?

Any inquiry concerning this communication should be directed to Joseph Gorski at telephone number (703) 308-1805.

Joseph Gorski:lf
May 20, 1999
June 2, 1999



Joseph M. Gorski
Primary Examiner